

REMARKS

This paper is filed in response to the Final Office Action mailed on October 11, 2005. A two-month extension of time and an RCE application is submitted herewith.

Claims 1, 9, 14, 17 and 20 have been amended; claims 4 and 21 have been cancelled.

Turing to the rejections based upon the prior art, claims 1, 7-9, 11, 13 and 20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 3,968,584 ("Kingston"). In response, claims 1 and 20 have been amended to traverse this rejection.

Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Amended claims 1 (and 14 for that matter) requires the light guide to comprise a plate-like structure made from a light transmitting material that extends parallel to *and spaced-apart from* the front plate and that the light guide engages the at least one three dimensional body to which it couples light. This arrangement provides the look of neon without the cost. Specifically, the three-dimensional object that is light by the light passing through the light guide looks like it is floating and not supported by a box or housing structure. This neon-like appearance is effective and can be provided at only a fraction of the cost of a neon light fixture. See page 4, lines 17-22 of the present application.

On the other hand, Kingston does not teach or suggest this combination. The Kingston light guide 5 is a solid structure that is not spaced apart from the front plate 12. While the Kingston light guide 5 is parallel to the front plate 12, the guide 5 does not have the requisite spaced-apart relationship to the front plate 12 and therefore Kingston cannot anticipate claim 1 (or teach all the elements of claim 14).

Further, with respect to claim 9 (and claim 17), Kingston does not teach or suggest the connection between a light guide and three-dimensional object that is laterally spaced outside of the front plate and opaque layer. In Kingston, the numbers 13 are all disposed inside of the opaque layer 14 and plate 12, not like the position of Figs. 3 and 4 of the present application where the three-dimensional objects 28, 28' are disposed beyond the front plate 25 and as now claimed in claims 9 and 17.

With respect to claim 20, Kingston clearly does not teach a light guide with a narrow edge that is perpendicularly engaged with the front plate beyond the opaque layer as claimed in amended claim 20 and shown in Fig. 1 of the present application. The light guide 5 of Kingston is a solid structure the abuttingly engages the front plate 12 and no narrow edge of the guide 5 engages the plate 12 or a gap in the opaque layer 14. Thus Kingston fails to teach or suggest the arrangement of claim 20 or the floating neon-like appearance of the lighted sign of claim 20.

Accordingly, in view of the amendments to claims 1 and 20, Applicants respectfully submit that the anticipation rejections of claims 1, 7-9 and 11, 13 and 20 based on Kingston are now moot.

Next, the Office Action rejects claims 2-3, 5-6, 10 and 14-19 under 35 U.S.C. § 103 as being unpatentable over Kingston in view of US Patent No. 5,536,558 ("Shelton"). Applicants respectfully submit that this rejection is improper for the following reasons.

Under MPEP § 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Claim 2-3, 5-6, 10 and 14-19 all depend from now-allowable claims 1 and 14. As noted above, Kingston does not teach or suggest a light guide that is a plate and that is spaced apart and parallel to the front plate. The light guide 5 of Kingston is not spaced apart from the plate 12. The light guide 5 of Kingston does not have an edge or end surface that engages a three dimensional body as recited in claims 2 and 14.

Shelton is cited for the proposition that it discloses a light guide 12 with edges or end surfaces that engage a three dimensional body. See page 4 of the office action which relies upon col. 11, lines 32-49 of Shelton. However, this passage does not teach that any edge 28 of the light guide 12 engages any three dimensional body; the cited passage only states the edges of the panels, which include a light guide, can be connected together to form a box. Thus the edges of the panels do not engage a three-dimensional structure as required by claims 2, 5 and 14, but instead, engage another two-dimensional panel. Further, Shelton does not teach or suggest any light guide that is parallel to and spaced apart from the front plate as recited in claims 1 and 14. As noted above, neither does Kingston.

Thus, there is no way to combine Kingston and Shelton to teach or suggest every element of amended claims 1 or 14 or claims 2 and 5. Because no combination of these two references teaches or suggests a light guide that is a plate-like structure that extends parallel to and space apart from a front plate as recited in claims 1 and 14 and because no combination of these two references teaches or suggests a plate-like light guide with an edge or end that engages a three dimensional body for coupling light thereto as recited in claims 2, 5 and 14, the obviousness rejection of claim 2-3, 5-6, 10 and 14-19 based on Kingston and Shelton is now moot.

Next, the Office Action rejects claim 12 under 35 U.S.C. § 103 as being unpatentable over Kingston in view of U.S. Patent No. 3,751,319 (“Green”). This rejection is now moot because claim 12 depends from now-allowable claim 1. The deficiencies of Kingston with respect to allowable claim 1 are discussed above. Kingston does not teach or suggest a plate-like light guide that is parallel to and spaced apart from the front plate to prove the floating neon-like effect. Green is

merely cited for the proposition that it teaches the use of a UV-hardening paste. Green teaches nothing about the structure or geometry of the light guide and therefore Green is irrelevant to claim 1 and cannot be combined with Kingston to establish a *prima facie* case of obviousness for claim 1. Because claim 1 is not obvious in view of Kingston and Green, claim 12 is not obvious in view of these two references as well and the obviousness rejection of claim 12 is now moot.

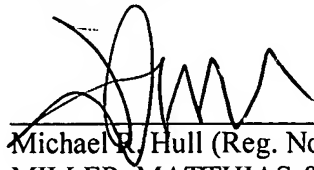
An early action indicating the allowability of this application is earnestly solicited.

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. § 1.17 to Deposit Account No. 50-3629.

Respectfully submitted,

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